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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
			EXAMINER PARTHASARATHY, PRAMILA	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/624,013

Applicant(s)

JESPERSEN ET AL.

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Applicant's submission filed on September 19, 2005 has been entered and made of record.

### ***Response to Arguments***

3. Applicant's arguments filed September 19, 2005 have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. The term "sufficient time" in claim 1 is a relative term which renders the claim indefinite. The term "sufficient time" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

The term "substantially" in claims 1 and 6 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The dependent claims 2 – 5 and 7 – 27 are rejected at least by virtue of their dependency on the dependent claims.

Applicant's remarks contain errors in arguments with respect to claim limitations. For example, page 2 lines 11 – 20, applicant discusses "unique transistory insignia" while the claimed limitation is "unique transitory insignia". Examiner requests the applicant for a careful review of the remarks for any such errors.

Regarding claim 1, Applicant argues that the cited prior art (Rowney et al. U.S. Patent Number 5,987,140, Oishi U.S. Patent Number 6,298,153), do not teach "a unique transitory insignia", "validating the insignia and upon positive validation, accepts the transaction" and "the insignia is invalidated immediately after validation".

Furthermore, applicant argues that the cited prior art do not teach, "secure the use of credit cards on the network" and "associate the payment transaction with a unique transitory insignia". These arguments are not found persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "secure the use of credit cards on the network" and "associate the payment transaction with a unique transitory insignia") are not recited in the rejected Claim 1. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner directs to Claim 1 which recites, "... a unique transitory insignia ...", "...validating through the legal entity C the unique transitory insignia, and upon positive validation, accepts the transaction.." and "... invalidating substantially immediately after validation ...".

Prior art is believed to read on the claims as "a unique transitory insignia" can be any information that can be used to verify the identity of the legal entity A (instant specification Page 4 lines 21 – 26), and "...validating through the legal entity C the unique transitory insignia, and upon positive validation, accepts the transaction ..", can be a bank, payment card company or any supporter which validates the information (instant application Page 5 lines 11 – 25). Rowney discloses a secure transmission of

data over a public communication system, wherein the payment gateway system evaluates the information and returns authorization (validates) or denial (invalidates) of credit via a secure transmission (Rowney Summary and Column 10 line 4 – Column 12 line 42).

Furthermore, “ .. invalidating substantially immediately after validation ...”, as invalidating the information so as to ensure that no one else can use that information (unique transitory insignia), (instant specification Page 6 lines 1 – 2), Oishi discloses a digital signature method including usage of using a digital certificate information (unique transitory insignia), wherein the certificate is used only once and thereafter it is discarded (invalidated) so that no one else can use that information (Oishi Summary and Column 18 34 – 43).

Oishi when combined with Rowney, discloses “... a unique transitory insignia ...”, “...validating through the legal entity C the unique transitory insignia, and upon positive validation, accepts the transaction ..” and “ .. invalidating substantially immediately after validation ...”, as detailed above.

Therefore, the examiner respectfully asserts that the cited prior art does teach or suggest the amended subject matter “... a unique transitory insignia ...”, “...validating through the legal entity C the unique transitory insignia, and upon positive validation, accepts the transaction ..” and “ .. invalidating substantially immediately after validation ...” broadly recited in the amended independent claim 1.

The dependent claims 2 – 27 are rejected at least by virtue of their dependency on the dependent claims and by other reason set forth in this office action.

Accordingly, the rejection for the pending claims 1 – 27 is respectfully maintained.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-9, 12, 13, 18, 23, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 in view of Oishi U.S. Patent No. 6,298,153 B1.

As to claim 1, Rowney et al discloses a method for performing a transaction between a legal entity A that has an approval to perform such transaction and a legal entity B over a network (column 10, lines 4-19). Rowney et al discloses the transaction being initiated by the legal entity A (column 10, lines 31-58). Rowney et al discloses the legal entity & associating the transaction with the verification insignia (i.e. certificate) to verify the approval to the legal entity B (column 11, lines 30-37). Rowney et al discloses that the verification insignia is a unique transitory insignia provided to the legal entity A by a legal entity C who thereby guarantees that the legal entity A has the approval (column 15, lines 56-64). Rowney et al discloses providing the unique transitory insignia

to the legal entity A by the legal entity C being conditioned by the legal entity A providing to the legal entity C a secret identification code (i.e. password) confirming the identity of the legal entity A to the legal entity C (column 12, lines 26-42). Rowney et al discloses that the legal entity B validates through legal entity C the unique transitory insignia, and upon positive validation, and only then, accepts the transactions (column 15, lines 56-64).

Rowney et al discloses that the transitory unique insignia is invalidated substantially immediately after the validation (column 10, lines 31-58).

Rowney et al does not teach that the unique transitory insignia is valid for a single transaction and valid only for sufficient time to complete a transaction. Rowney et al does not teach invalidating substantially immediately after the validation of the transitory unique insignia.

Oishi teaches a certificate that is valid for only a single transaction and valid only for sufficient time to complete a transaction (column 18, lines 33-43). Oishi teaches the legal entity C invalidating substantially immediately after the validation of the certification (column 18, lines 33-43).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Rowney et al so that the certificate would have only been valid for a single transaction and valid only for sufficient time to complete the transaction. The certificate would have been invalidated substantially immediately after the validation of the certification. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to have

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modified Rowney et al by the teaching of Oishi because it ensures that the certificate is not subject to a replay attack.

As to claim 2, Rowney et al teaches that the validation is guaranteed by the legal entity C (column 15, lines 56-64). Rowney et al teaches that the legal entity C upon the guaranteeing invalidates the unique transitory insignia (column 10, lines 31-58).

As to claim 3, Rowney et al suggests that a first timestamp (i.e. issue date) is recorded by the legal entity C, the first timestamp comprising the date and time of the provision of the unique transitory insignia to the legal entity A by the legal entity C (column 11, lines 30-37). The examiner asserts that it is well known in the art that a digital certificate contains the issue date.

As to claim 4, Rowney et al suggests that a second timestamp is recorded by the legal entity A (column 11 lines 30-37). Rowney et al suggests that the second timestamp comprises the date and time when the legal entity & to verify the approval to the legal entity B, associates the transaction with a verification insignia (column 18, lines 20-33).

As to claim 5, Rowney et al suggests that the unique transitory insignia comprises the first timestamp (column 11 lines 30-37).

As to claim 6, Rowney et al suggests that the transitory unique insignia is invalidated by the legal entity C substantially immediately after a pre-specified time counted from the time recorded in the timestamp (i.e. validity period) (column 11, lines 30-371. The examiner asserts that it is well known in the art that a digital certificate contains a validity period that is counted down from the issue date.

As to claim 7, Rowney et al suggests that the pre-specified time is between 10 millisecond and 5 minutes (column 9, lines 24-32).

As to claim 8, Rowney et al teaches verifying of the correctness of the unique transitory insignia (column 15, lines 56-64).

As to claim 9, Rowney et al teaches that the public network is the internet or any other public, semi-public, private or semi-private network (column 9 lines 51-61).

As to claim 12, Rowney et al teaches that the unique transitory insignia has a unique identification number (column 11, lines 30-371. The examiner asserts that it is well known in the art that digital certificates contain a unique identification number.

As to claim 13, Rowney et al suggests that the unique identification number is associated with a financial agreement between the legal entity A and a trusted partner

of the legal entity C (column I 1, lines 30-37). The examiner asserts that it is well known in the art that digital certificates contain a unique identification number.

As to claim 18, Rowney et al teaches that the legal entity C requests a payment by the legal entity B, the request being associated with the unique transitory insignia (column 17 line 37 to column 18 line 11).

As to claim 23, Rowney et al teaches that the unique transitory insignia (i.e. digital certificate) is comprised in a digital code (column 11 lines 30-37).

As to claim 26, Rowney et al teaches that the pre-specified time is between 30 seconds and 4 minutes (column I 1, lines 30-37).

As to claim 27, Rowney et al suggests that the pre-specified time is 2 minutes (column 11, lines 30-37).

7. Claims 10, 24 and 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 and Oishi U.S. Patent No. 6,298,153 B1 as applied to claim 1 above, and further in view of Puhl et al U.S. Patent No. 6,223,291 B1.

As to claim 10, the Rowney-Oishi combination does not teach that the network uses a wireless application protocol. Puhl et al teaches a network that is adapted to use

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a wireless application protocol (column 2, lines 37-43). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination so that the network was implemented using a wireless application protocol. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination by the teaching of Puhl et al because it allows clients to perform electronic commerce over a wireless network with enhanced security (column 1, lines 35-57).

As to claims 24 and 25, the Rowney-Oishi combination does not teach that the digital code (i.e. certificate) is generated in a cellular phone, by means of a digital device provided by the legal entity C. Rowney et al does not teach that the digital code is encrypted. Puhl et al teaches that the digital code (i.e. certificate) is generated in a cellular phone, by means of a digital device provided by the legal entity C. Puhl et al teaches that the digital code is encrypted.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination so that the certificate was generated by a cellular phone provided by the third party. The certificates would have been encrypted during sessions. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination by the teaching of Puhl et al because it allows

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clients to perform electronic commerce over a wireless network with enhanced security (column 1, lines 35-57).

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 and Oishi U.S. Patent No. 6,298,153 B1 as applied to claim 1 above, and further in view of Aziz U.S. Patent No. 6,223,291 B1.

As to claim 11, the Rowney-Oishi combination teaches that the verification insignia is provided to the legal entity A by the legal entity C, as discussed above. The Rowney-Oishi combination does not teach that it is transmitted over the Internet through a secure communication channel protected by the secret identification code.

Aziz teaches a secure communication channel on the Internet protected by the secret identification code (i.e. password) (column 6, lines 4-18). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination so that password would have been used to secure the communication channel on the Internet. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination by the teaching of Aziz because it protects the connection from being taken over by an attacker (column 1, lines 31-38).

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 and Oishi U.S. Patent No. 6,298,153 B1 as applied to claim 1 above, and further in view of Haber et al U.S. Patent No. 5,136,646.

As to claim 22, the Rowney-Oishi combination does not teach that the unique identification number is selected from a pool of numbers agreed between the legal entity C and the trusted partners of the legal entity C. The Rowney-Oishi combination does not teach that the number is released after the transitory unique insignia has been invalidated.

Haber et al teaches that the unique identification number (i.e. transaction number) is selected from a pool of numbers agreed between the legal entity C and the trusted partners of the legal entity C (column 4, lines 56-671. Haber et al teaches that the number is released after the transitory unique insignia has been invalidated (column 6, lines 33-41). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination so that the unique identification on the certificate was the transaction number as taught by Haber et al. After the merchant authenticates the certificate and invalidates it, the receipt with the transaction number would have been released. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination by the teaching of Haber et al because the receipt provides proof of the transaction (column 3, lines 10-27).

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10. Claims 14, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 and Oishi U.S. Patent No. 6,298,153 B1 as applied to claim 1 above, and further in view of Franklin et al U.S. Patent No. 5,883,810.

As to claims 14, 20 and 21, the Rowney-Oishi combination does not teach that the financial agreement comprises the trusted partner of the legal entity C providing the legal partner A with a payment card. The Rowney-Oishi combination does not teach that the unique number is selected in accordance with a unique number of the payment card. The Rowney-Oishi combination does not teach that the unique number is selected in accordance with a unique issuer identification number of the legal entity C or in accordance with a unique identification number of trusted partners) of the legal entity C.

Franklin et al teaches that the financial agreement comprises the trusted partner of the legal entity C providing the legal partner A with a payment card (i.e. credit card) (column 4, lines 36-47). Franklin et al teaches that the unique number is selected in accordance with a unique number of the payment card (i.e. credit card number).

Franklin et al teaches that the unique number is selected in accordance with a unique issuer identification number of the legal entity C or in accordance with a unique identification number of trusted partners) of the legal entity C (column 4, lines 48-65).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination so that the issuing bank would have issued the credit card and the certificate. The certificate would have contained the credit card number. It would have been obvious to

a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination by the teaching of Franklin et al because it substantially reduces the value of a stolen number since the number is only a proxy number for a single purchase. Stealing the proxy number would not greatly benefit a thief because it cannot be repeatedly used for other purchases or transactions. Another benefit is that the system integrates with existing card verification and settlement protocols. All parties, except the issuing bank, are able to treat the transaction number of the online commerce card in the same manner in which they process a Visa or MasterCard transaction today. No additional processing software is needed at the merchants or settlement participants (column 12, lines 10-20).

**11.** Claims 15-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowney et al U.S. Patent No. 5,987,140 and Oishi U.S. Patent No. 4,298,153 B1 as applied to claim 1 above, and further in view of Collin U.S. Patent No. 6,223,291 B1.

As to claims 15-17 and 19, the Rowney-Oishi combination does not teach that the unique identification number comprises at least a first and a second identification component. The Rowney-Oishi combination does not teach that the first identification component identifies the financial agreement and the second identification component identifies the legal entity Rowney et al does not teach that the second identification component is assigned to the legal entity C by a registration authority agreed between the legal entity C and a number of trusted partners of the legal entity C. The Rowney-

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Oishi combination does not teach there is interdependency between the financial agreement and a disbursement account. The Rowney-Oishi combination does not teach that the payment is withdrawn from the disbursement account.

Collin teaches that the unique identification number comprises at least a first and a second identification component. Collin teaches that the first identification component identifies the financial agreement (i.e. debit card number) (column lines 4-1) and the second identification component (i.e. certificate issuer) identifies the legal entity C.

Collin teaches that the second identification component is assigned to the legal entity C by a registration authority agreed between the legal entity C and a number of trusted partners of the legal entity C (column 10, lines 14-30). Collin teaches there is interdependency between the financial agreement and a disbursement account (i.e. your debit account).

Collin teaches that the payment is withdrawn from the disbursement account (column 11, lines 34-58). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination so that the third party would assign a debit account with a user and a certificate. The certificate would contain the debit card account number as well as the certificate issuer. Every time the certificate was passed and used for a purchase, funds would be taken out of the corresponding debit account. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the Rowney-Oishi combination by the teaching of Collin because give a

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customer an opportunity to make purchases over the Internet and have funds withdrawn from their debit account securely.

### ***Conclusion***

**12.** Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

**13.** Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.


**14.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-

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272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy  
September 23, 2005.

  
Primary Examiner  
AU2131  
9/27/05